

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the rejection of claim 1, it is stated on pages 2 and 3 of the Office Action that Takeda *does not teach using an identifier code on a substrate*. It is stated that Irons teaches scanning a document with a bar-coded label in order to identify and index a document with other related documents. The combined teachings of Takeda and Irons fails to disclose or suggest positively recited limitations of claim 1.

Irons merely refers to placing a label on a document as set forth in col. 7, line 65 spanning to col. 8, line 14. The document is scanned to create an image including the label. A document number which links the document image to a record in the database is extracted from the label. Accordingly, the label includes a document number associated with the document on which the label is provided.

Claim 1 clearly recites storing a first communication as data in a database, *associating at least a portion of the first communication together with the identifier code on a substrate; changing the first communication on the substrate to form a second communication which is different from the first communication; and scanning the second communication and the identifier code with a scanning machine to *digitize the second communication and the identifier code**. Claim 1 recites patentable subject matter.

Takeda fails to disclose any identifiers on a substrate. Irons merely provides the label upon pages of the respective document. The combined teachings of the prior art fail to disclose or suggest changing a first communication on the substrate to form a second communication and scanning the second communication and the identifier code as positively recited in claim 1. Irons only provides the label with the respective document and fails to disclose or suggest the changing and the scanning of the second communication and the identifier code. Limitations of claim 1 are not shown or suggested and claim 1 is allowable for at least this reason.

In addition, claim 1 stands rejected over numerous prior art references. Referring to MPEP §2143.01 (8th ed.), there must be some suggestion or

Serial No. 09/325,910
Case No. 10990146-1
Amendment A

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by a combination of references unless there is some motivation in the art to support the combination. See *ACH Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The motivation for forming the combination must be something other than *hindsight reconstruction based on using Applicant's invention as a road map for such a combination*. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is stated of pages 2-3 of the Office Action that it would have been obvious to modify Takeda's methods with Irons system for labeling a document for indexing an image storage and retrieval since Irons system allows the user to index and label the documents prior to scanning by using a labeling mechanism. Upon scanning, it is stated that the user can then associate the document with other documents in the database record. Applicant disagrees with the alleged motivation identified in the Office Action and submits that proper motivation is lacking to support a 103 rejection.

Takeda is replete with teachings of document identification and storage. For example, in column 4, lines 54-64, it is stated that a *keyword 34 is added for image retrieval purposes and the like*. The keyword may be replaced by bar codes. The keyword 34 is stored in memory 7. As set forth in column 7, lines 12-24, it is stated that the *keyword may be inputted by a user to search an original image*. An image may be searched from the image file using the given keyword as set forth in Takeda. Further, column 4, lines 41-44 of Takeda provide inputting of information such as *keywords for image retrieval using keyboard 6 stored in image file 3 in one-to-one correspondence with an image* 22.

Accordingly, Takeda utilizes keywords to provide document retrieval and association with images within memory. There is absolutely no motivation for one of ordinary skill in the art to look at Irons for additional teachings with respect to document labeling and association inasmuch as Takeda already discloses such methodology utilizing the explicitly disclosed keywords. Indeed, keywords 34 are clearly illustrated in Fig. 2 associated with a respective image 23.

It follows that the motivational rationale provided for the combination is redundant and lacking, and therefore, the obviousness rejection is improper. The Examiner is respectfully reminded that a proper motivational rationale for a combination of art provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted)). The primary reference of Takeda already provides keywords for image storage and retrieval. Accordingly, why would one skilled in the art look to Irons to modify the invention of Takeda when Takeda already provides for the teachings for which Irons is allegedly presented? Such a redundancy clearly demonstrates there is **no impetus** for one skilled in the art to modify the Takeda invention with the teachings of Irons, and therefore, the alleged motivational rationale for the combination is faulty. Moreover, since the motivational rationale is improper, the obviousness rejection fails and should be withdrawn. The Examiner has improperly utilized Applicant's disclosure as a road map for combining the teachings of Irons with the teachings of Takeda. The 103 rejection of claim 1 is improper and Applicants respectfully request allowance of claim 1 in the next Office Action for at least this additional reason.

Column 7, lines 23-45 of Takeda describe creation of difference images 27, 28. It is stated that *keyword 43 is erased* by changing black pixels to white pixels. As shown in Fig. 2, absolutely none of the substrate images 21, 24, 25 include any keywords. Keywords of Takeda are only utilized for images stored within memory as shown by images 23, 26, 27. In fact, Takeda explicitly discloses erasure of keywords as set forth in column 7, lines 38-40. Irons

Serial No. 09/325,910
Case No. 10990146-1
Amendment A

relates to generation of a document number utilized to link a document image to a record in a database as set forth in column 7, line 50 spanning to column 8, line 14. *Desktop labeling mechanism 202 generates a label utilized to identify a document. The label is applied to a first page of the incoming document or on each page of a paper-based document prior to scanning.* As set forth above, the keyword of Takeda is provided with a memory and no labeling is provided upon printed paper. One of ordinary skill in the art would not look to combine the labeling of paper documents of Irons with the teachings of Takeda. In fact, the combination of reference teachings of the document labeling system of Irons with Takeda as alleged in the Office Action is directly contrary to the explicit teachings of Takeda. Takeda teaches away from the alleged combination by only providing keywords in memory and erasing such keywords. The teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). The 103 rejection is improper for this additional reason.

As mentioned above, column 4, lines 41-44 of Takeda provide inputting of information such as *keywords for image retrieval using keyboard 6 stored in image file 3 in a one-to-one correspondence with an image 22*. Accordingly, any modification of Takeda to allegedly obviate claim 1 defining an identifier code of first and second communications is directly contrary to the one-to-one explicit teachings of Takeda. The proposed modification of Takeda set forth in the Office Action is inappropriate for at least this additional reason.

It is further stated on page 3 of the Action that Takeda and Irons do not disclose comparing a second communication with data of a first communication to identify differences. It is stated that it would have been obvious to combine the teachings of Hug with the system disclosed by Takeda and Irons since their system consists of modified/corrected versions of the same document. The bald conclusory statements of the Office Action fail to provide the requisite motivation to combine the teachings of Hug with the combined teachings of Takeda and Irons.

The Federal Circuit recently discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references can not be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office can not rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 1 is improper without the proper motivation and Applicants respectfully request allowance of claim 1 in the next action for at least the above-identified numerous reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent

claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 5 stands rejected over Takeda, Irons, Hug and Oliver. Oliver discloses a converter for an optical scanner. Oliver is non-analogous art. Non-analogous art areas cannot properly be combined for an obviousness rejection where the problems addressed by each are non-analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986.) A field of art is analogous *only* if one seeking the solution in one art area would be likely to seek the solution by referring to the other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 USPQ 634 (Fed. Cir. 1985). The combination of non-analogous art areas is precluded by long standing Federal Circuit precedent. Prior art references are only analogous if the reference is in the field of Applicant's endeavor or the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01 (8th ed.) (citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Oliver's converter for an optical scanner is not in the field of Applicant's endeavor and Oliver is not reasonably pertinent to a particular problem with which the inventor was concerned. Accordingly, the obviousness rejection of claim 5 should be reversed for at least this additional reason.

In addition, on page 5 of the Office Action, it is stated that the rejection of claim 5 is appropriate because "it was well known at the time of the invention." Applicant disagrees. This is the type of analysis that the U.S. PTO Board of Patent Appeals and Interferences **explicitly states is inappropriate** (see MPEP §2143.01 citing to *Ex Parte Levengood* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). MPEP §2143.01 sets forth that a statement that modifications of the prior art to meet the claimed invention would have been well known because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. The Examiner simply states a conclusion contrary to case law and the MPEP.

In addition, the undersigned hereby traverses and seasonably challenges the assertion pursuant to MPEP §2144.03 (8th ed.), and requests the Examiner cite a reference in support of his or her position. Applicant believes reasonable doubt exists regarding the Examiner's assertion. The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that method claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed.), Applicant hereby demands evidence with respect to what the Examiner apparently relies upon as being "well-known".

Referring to the rejection of claim 6, no less than five references are relied upon in support of the obviousness rejection. The fact that the Examiner combines so many references in an attempt to show that Applicant's claimed invention is obvious illustrates exactly why the invention is not obvious. There is simply nothing like or suggestive of Applicant's claim 6 invention in the prior art. The Examiner has searched and found small pieces of the invention scattered amongst a combination of five references with inapposite teachings. A person of ordinary skill in the art would not combine the cited inapposite teachings. Further, the large number of references cited makes the Examiner's position tenuous in the extreme. Proper motivation for the combination of the numerous references is lacking leaving the only plausible explanation for the combination as reliance upon improper hindsight reconstruction utilizing Applicant's disclosure as a road map. The Examiner has impermissibly used Applicant's teachings to examine the prior art for the individually claimed elements and then independently and mistakenly reach a conclusion of obvious. The reliance upon five reference teachings results from hindsight reconstruction rather than clear and particular motivation in the prior art and the rejection of claim 6 should be reversed for at least this reason.

Further, Belucci's system for producing a personal ID card is non-analogous subject matter and has been improperly relied upon in support of the

Serial No. 09/325,910

Case No. 10990146-1

Amendment A

rejection of claim 6. In addition, on page 5 of the Office Action, it is stated that the rejection of claim 6 is appropriate because "it is well known features for data protection." Applicant demands evidence in support of the assertion that limitations of claim 6 are "well known." The rejection of claim 6 is improper for at least the above numerous reasons.

Claim 7 recites a method of document retrieval comprising, in part, providing a database having multiple versions of a document stored therein as datasets, forming a hard copy defined as *a first version of the document and having the common document specific code and the version specific code*, providing the document specific code and version specific code to a processor and the processor *extracting at least a portion of a second version of the document from a dataset corresponding to the second version of the document*. Takeda provides keywords corresponding to *respective images* 23, 27 and fails to disclose or suggest the extraction of the *second version* performed by the processor recited in claim 7. Irons recites providing a *document number on a respective document* which is scanned and utilized to link the *respective document to a record in a database*. Hug merely refers to storing a delta-formatted document which generally requires less storage an entire alternative version. Accordingly, even if the inapposite teachings of the prior art are combined, positively recited limitations of claim 7 including providing the document specific code and the version specific code from the first version of the document to a processor and extracting at least a portion of a second version using the processor are not shown or suggested in the prior art of record. Claim 7 is allowable for at least this reason.

In addition, there is absolutely no motivation to combine the teachings of Irons with the teachings of Takeda in support of the obviousness rejection. Further, the explicit teachings of Takeda teach away from the proposed modification alleged in the Office Action. The teaching away illustrates the non-obvious nature of the invention of claim 7. The obviousness rejection of claim 7 is improper for at least these additional reasons.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent

Serial No. 09/325,910
Case No. 10990146-1
Amendment A

claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, on page 6 of the Office Action, it is stated that the 103 rejection of claim 9 is proper since "it was common in the art to utilize such features in document processing." This alleged bald, cursory motivational rationale is entirely deficient as set forth by the *In re Lee* court. The rejection of claim 9 is improper.

With reference to claim 11, the alleged motivational rationale set forth on page 6 of the Office Action to combine reference teachings because the system "deals with multiple versions of a document" as do Takeda and Irons is insufficient to provide the impetus necessary to go in the claimed direction. The rationale is deficient under *In re Lee*, and Applicants request allowance of such claims in the next action.

Claim 13 recites a method of storing and receiving information, comprising, in part, publishing at least a portion of a first version of a communication together with a first identifier code, and retrieving a selected one of first and second versions of the communication comprising, in part, providing the *published first identifier code to a processor* and the processor being configured to utilize the first and second identifier codes to retrieve and compare the *first and second data sets* and further configured to recognize that multiple versions of the communication were saved and to prompt a user to select which of the multiple versions is to be displayed. Claim 13 recites patentable subject matter.

The combined teachings of Takeda, Irons and Hug fail to disclose or suggest any provision of a *published first identifier code to a processor* and the processor being configured to *utilize first and second identifier codes to retrieve and compare* the first and the second data sets, and to *recognize that multiple versions of the communication were saved to the database as multiple data sets*. Takeda and Irons relate to associating labels with *respective documents* and fail to disclose plural identifier codes for retrieval and comparison of plural data sets. The identified teachings in columns 9-10 of Hug as set forth on page 7 of the Action also fail to cure the deficiencies of Takeda and Irons with

respect to the limitations of claim 13. Positively recited limitations of claim 13 are not shown or suggested in the art and claim 13 is allowable for at least this reason.

Further, there is no motivation to combine the teachings of Irons with the teachings of Takeda in support of the obviousness rejection. In addition, the explicit teachings of Takeda teach away from the proposed modification alleged in the Office Action. The teaching away illustrates the non-obvious nature of the invention of claim 13. The obviousness rejection of claim 13 is improper for at least these additional reasons.

The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

The presented motivational rationale in support of the 103 rejections for claims 14-16, and 18-20 is conclusory and contrary to the Federal Circuit's holding of *In re Lee*. The rejection of the claims is improper for this additional reason.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable. Specifically, Applicants at least request positive identification of specific

teachings of the prior art which allegedly correspond to at least the limitations identified above.


Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Keith E. Moore

10/11/02

By


James D. Shaurette
Reg. No. 39,833
October 9, 2002
(509) 624-4276